REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated October 6, 2003, are respectfully requested. A Petition for a 3-month Extension of Time is attached.

The attorneys for the applicant wish to thank the Examiner for the thorough Office Action, including the specific citations to portions of the applied references and the elements of the claims to which those portions relate.

I. Disclosed Embodiments of the Invention

Embodiments of the invention are directed to methods and systems for communicating and controlling data in a network. More specifically, incoming telephone calls to a network are managed and controlled when subscribers to the network do not have multiple telephone lines in the network. Thus, as opposed to existing systems in which a subscriber to a network has only one line or telephone number to access the network and receive services, embodiments of the invention address a need in the art for ways to manage multiple incoming calls to a subscriber and to ensure that subscribers receive all of the services they subscribed to and that are provided by the network. For example, facsimile transmissions can be sent simultaneously with voice signals over a single channel with one telephone number without either call being missed. In one embodiment, facsimile transmissions are automatically stored and forwarded when the single telephone line is busy with a voice call, addressing a need for methods which store and forward incoming calls when only a single telephone line is available for multiple incoming calls.

II. The Applied Art

U.S. Patent No. 6,167,123 to Kwok et al. (*Kwok et al.*) is directed to a call discrimination system which provides voice, facsimile, and data services utilizing one telephone number for each local line being serviced under a PBX system. *Kwok et al.* discloses a system for identifying an incoming call as either a facsimile transmission or a voice call and means for routing the call to the intended destination. An incoming call is received and connected to a local line with each subscriber being identified by a DID

(direct inward dial number). Column 2, lines 36-40. After the subscriber answers the call, a call identifier identifies the type of call by detecting audible tones that are associated with facsimile and modem transmissions. Column 3, lines 18-23. If no tone is detected, then the call is assumed to be a voice call and is routed directly to the subscriber. Column 3, lines 23-24. If a tone is detected, then the PBX system of *Kwok et al.* assumes that the call is a facsimile call and routes it to a fax line on the fax server. Column 3, lines 24-26. Since the routing of fax calls occurs after the subscriber has answered the phone, the PBX system can notify the subscriber that the facsimile call has been received via a pre-recorded announcement, a text display, or an e-mail. Column 3, lines 27-32. Column 4, lines 10-17. Under an alternative embodiment, after receiving a facsimile call, the subscriber can manually inform the system of the type of call by pressing a button on the telephone that activates the feature code, allowing the system to route the facsimile to a predefined destination. Column 3, lines 33-46.

U.S. Patent No. 6,546,085 to Brockman et al. (*Brockman et al.*) is directed to a system and method that enables a calling party to verify the delivery or the cancellation of a stored facsimile. *Brockman et al.* discloses a voice mail system that receives an incoming telephone call and compares an incoming caller ID with the caller ID's stored in conjunction with previous facsimiles. If a caller ID of the incoming call matches a caller ID in the database, then the calling party is presented with a menu of options. The fax machine subscribes to the voice mail service for storage purposes. Column 2, lines 16-29.

III. Rejections under 35 U.S.C. § 102

Distinctions between claim 1 and *Kwok et al.* will first be discussed, followed by distinctions between *Kwok et al.* and the remaining independent claims.

As noted above, *Kwok et al.* discloses call discrimination in a PBX system which provides voice, facsimile, and data services utilizing one telephone number for each local line being serviced. Such a system requires the subscriber to answer each call, even if it is a fax call, and in one embodiment to inform the PBX system of the type of incoming call by manually activating a feature code to allow the call to be routed to a predefined destination. Column 3, lines 34-44. Thus, *Kwok et al.* either performs a

system-wide "automatic" routing of fax calls, or a manual routing for fax calls by requiring the subscriber to enter the feature code: there is no middle ground. In sum, *Kwok et al.* fails to disclose automatically determining whether an individual subscriber in a system has an automatic fax routing feature activated for incoming calls to that subscriber. Claim 1 has been amended to clarify inherent language of previously pending claim 1. In other words, claim 1 has been amended to recite, among other limitations, that the method includes automatically determining "whether the subscriber has activated an automatic routing feature that automatically routes incoming calls based on whether they are of the first character or the second character." Thus, each subscriber under the method of claim 1 may personally and individually determine whether to automatically route calls or not based on whether the subscriber has decided to activate the automatic routing feature. See, e.g., p. 8, line 22 – p. 9, line 9. *Kwok et al.* discloses only a system-wide automatic method for determining whether the subscriber has a feature activated that is associated with the incoming call, or a manual, call-by-call, routing. For at least this reason, the applicant believes claim 1 is patentable over *Kwok et al.*

Claim 1 is allowable for other reasons too. For example, the system of *Kwok et al.* is a PBX. PBX systems suffer from various shortcomings known by those skilled in the art. The method of claim 1 is not so restricted, and claim 1 has been amended to clarify that the claimed method is performed in a "non-PBX-type network." Further, the PBX system of *Kwok et al* suffers from the strange requirement that all calls are answered by the subscriber, regardless of whether fax-specific calls are to be automatically or manually routed. See, e.g., col. 3, lines 18-20 and 35-38. Claim 1 has been further amended to clarify that calls may be automatically routed " without the subscriber having to first answer the incoming telephone call".

The remaining independent claims recite, at least in part, substantially similar features. For example, claim 9 clarifies that the method applies to non-PBX-type network calls. Further, claim 9 has been amended to clarify storage of facsimile messages in a subscriber's personal voice mail system, namely "automatically routing the incoming call to another location if the incoming call is classified as a facsimile type of call, and storing the facsimile call in a voice mail system that is associated with the

subscriber's telephone line." *Kwok et al.* requires the incoming facsimile to be routed to a specific destination. *Kwok et al.* fails to disclose the ability to store facsimile in a voice mail system that the subscriber's telephone subscribes to. As explained below, *Brockman et al.* fails to make up for the deficiencies of *Kwok et al.* For at least these reasons, claim 9 is patentable over *Kwok et al.*

Kwok et al. discloses the detection of a tone associated with an incoming facsimile to classify the type of call. *Kwok et al.* fails to disclose the ability to detect the tone associated with a facsimile before the subscriber answers the telephone. In *Kwok et al,* the tone associated with a facsimile is detected after the subscriber answers the telephone, as noted above. Column 3, lines 18-23. Claim 15 has been amended to clarify such an inherent aspect, namely that "a tone associated with an incoming facsimile transmission is detected before the subscriber answers the telephone and is used to classify the incoming call as one of the first character or the second character." Claim 15 further recites, among other limitations, "an automatic routing module for routing the incoming telephone call to a location depending upon its classification as a telephone call of the first or second character based in part upon whether individual subscribers have activated an automatic routing feature for automatically routing incoming calls based on whether they are of the first character or the second character." For at least these reasons, claim 15 is patentable over *Kwok et al.*

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim.[1] *Kwok et al.* fails to disclose every limitation recited in claims 1, 9, and 15. Thus, independent claims 1, 9, and 15 are patentable over *Kwok et al.*

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[1] MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). *See also, Ex parte Levy,* 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

IV. Rejections under 35 U.S.C. § 103

The Applied References Even if Combined, Fail to Disclose or Suggest the Claimed Invention.

As noted above, *Kwok et al.* discloses a method for routing incoming facsimile, butfails to disclose a method in which incoming facsimiles are automatically routed for storage in a voice mail system that is associated with a subscriber's telephone line or associated with the subscriber's telephone. *Brockman et al.* discloses a method in which incoming facsimile is routed for storage in a voice mail system that the fax machine itself subscribes to. Column 2, lines 16-17 and lines 24-29. *Brockman et al.* fails to disclose a system in which the telephone line or phone, not the fax machine, subscribes to the voice mail system. As explained below, *Kwok et al.* and *Brockman et al.* would not be combined. However, even if they were combined, neither *Kwok et al.* nor *Brockman et al.* teach or suggest storing an incoming facsimile in a voice mail system that the subscriber's telephone line subscribes to. Claim 9 recites, among other limitations, the ability of " storing the facsimile call in a voice mail system that is associated with the subscriber's telephone line or associated with a telephone of the subscriber's." In other words, the invention of claim 9 includes storing incoming facsimile in a voice mail system that the subscriber's telephone line subscribes to, which is not disclosed in either *Kwok et al.* or *Brockman et al.* Claim 15 recites, *inter alia*, similar limitations.

Possibly more importantly, *Brockman et al* teaches away from the claimed invention. Under *Brockman et al* a subscriber who acquired a facsimile machine would need to obtain a separate phone line (and number), and a voice mail account. The subscriber would already have a phone and associated, separate phone line/number, and likely a separate voice mail account. The applicant recognized the problems of such redundancy and cost, which are problems discussed in the background section of the application. The presently claimed invention, which employs routing of calls to a single number and to a voice mail box associated with the subscriber's line/phone, overcomes the problems associated with *Brockman et al.*

The Applied References Lack a Specific Suggestion to Combine Them As Argued in the Office Action

Independent claims are allowable not only because they recite limitations not found in the references (even if combined), but for at least the following additional reasons. For example, there is no motivation to combine the various references as suggested in the Office Action. According to the Manual of Patent Examining Procedure ("MPEP") and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and thus overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two references.[2] The MPEP provides similar instructions.[3] *Brockman et al.* contains no specific teachings that would suggest combining *Brockman et al.* with *Kwok et al.*

Conversely, and in a manner similar to that rejected by the Federal Circuit, the present Office Action lacks any description of a motivation to combine the references. Thus, if the current rejection is maintained, the applicant's representative requests that the Examiner explain with the required specificity where a suggestion or motivation in the references for so combining the references may be found.[4]

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[2] In re Sang-Su Lee, 277 F.3d 1338, 1341-1343 (Fed. Cir. 2002).

[3] Manual of Patent Examining Procedure, Section 2143 (noting that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing in re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

[4] See, MPEP Section 2144.03.

As is known, one may not use the application as a blueprint to pick and choose teachings from various prior art references to construct the claimed invention ("impermissible hindsight reconstruction").[5] Assuming, for argument's sake, that it would be obvious to combine the teachings of *Kwok et al.* and *Brockman et al.*, then *Kwok et al.* would have done so because it would have provided at least some of the advantages of the presently claimed invention. *Kwok et al.'s* failure to employ the teachings cited in *Brockman et al.* is persuasive proof that the combination recited in claims 9 and 15 is unobvious.

V. Conclusion

Overall, independent claims 1, 9, and 15 are patentable over the applied references. Since these independent claims are allowable, based on at least the above reasons, the claims that depend from them are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3599.

Respectfully submitted,
Perkins Coie LLP

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Christopher J. Daley-Watson
Registration No. 34,807

[5] See, *e.g.*, In re Gorman, 933 F.2d 982,987 (Fed. Cir. 1991), ("One cannot use hindsight construction to pick and choose between isolated disclosures in the prior art to deprecate the claimed invention.").

Correspondence Address:
Customer No. 30083
Perkins Coie LLP/AWS
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000